

REMARKS

Claims 1-23, 25-30, 33, 34, 36-42, 44-49, 52, 53, 55-60 are pending. Claims 23, 33, 42, 52 and 60 are independent. Claims 24, 31, 35, 43, 50, 54 and 61 have been canceled. Claims 23, 33, 42, 52, 59 and 60 have been amended.

Reconsideration of this application, as amended, is respectfully requested.

Rejections under 35 U.S.C. 103

Claims 23, 26-30, 33-34, 36-42, 45-49, 52-52 and 55-60 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al. ('446) in view of Yuen et al. ('409) and Official notice. Claims 24, 31, 35, 43, 50, 54 and 61 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al. ('446) in view of Yuen et al. ('409) and Official notice, and further in view of Enokida ('393). Claims 25 and 44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al. ('446) in view of Yuen et al. ('409) and Official notice and further in view of Naimpally ('993). These rejections are respectfully traversed.

PRIMA FACIE CASE OF OBVIOUSNESS

In order to establish a prima facie case of obviousness the Examiner must establish that all of the references relied upon qualify as prior art under at least one of the sections of 35 U.S.C. 102. All of the rejections of record include the Yuen et al. Patent ('409). The Yuen et al. patent issued from a continuation-in-part (CIP) application filed September 16, 1993.

In Applicants' response filed October 30, 2001, Applicants perfected their claim to foreign priority, thereby establishing an effective filing date of April 16, 1993. Therefore, the present invention has an earlier filing date than the CIP application itself, meaning that the CIP application, standing alone, does not qualify as prior art.

Applicants note that the CIP application claims priority on an earlier filed application. However, a CIP application typically adds disclosure to a parent application. Therefore, it is the Examiner's burden to establish that the material relied upon in published Yuen et al. patent, which issued from the CIP application, is found in the parent application. Further, the Examiner must establish that the parent application, as filed, met all aspects of the requirements of 35 U.S.C. 112, first paragraph (enablement, written description and best mode). Otherwise, the CIP application does not get the benefit of a 102(e) date of the parent application, and hence does not qualify as prior art against the present application.

In this regard, the Examiner is asked to consider the similar circumstances of In re Wertheim, 646 F.2d 527, 209 USPQ 554 (CCPA 1981), as discussed in the MPEP (seventh edition, revision 1) at section 2136.03, heading IV.

SUBSTANTIVE TRAVERSAL

In addition to the argument above, Applicants disagree with the Examiner's present rejections of record. Particularly, Applicants respectfully asserted that the prior art of record fails to show or suggest a combination of structural features and method steps as recited in the amended independent claims 23, 33, 42, 52 and 60.

Ishii et al. fails to show or suggest a "digital" video recording or reproducing device or medium. Moreover, Ishii et al. fails to show or suggest digital video data including relative position data and specific data, wherein each specific data includes an associated relative position data, as well as intra-coded digital picture data. Ishii et al. also fail to show or suggest that the associated relative position data, for each specific data, is indicative of a current nth specific data location on the digital video recording medium to each of a n+1, n+2, ..., n+m specific data location on the digital video recording medium, where m is greater than 2.

Assuming that the Examiner can show that Yuen et al. does qualify as prior art, Applicants still respectfully assert that Yuen et al. fail to cure the

deficiencies of Ishii et al. The Yuen et al. reference was discussed during the personal interview of June 6, 2001 (paper no. 22). In the interview summary, the Examiner wrote, "The differences between the claimed invention and Yuen et al. ('409) have been discussed. It appears that the claimed invention overcomes the applied references."

Yuen et al. disclose recording video programs on a magnetic tape. The video programs are recorded in an "analog" format. Hence, Yuen does not cure the "digital" shortcoming of Ishii et al.

For each frame of video in Yuen et al., directory information is recorded in the vertical blanking interval (VBI). The directory information, as shown in Fig. 3 of Yuen, includes the title of the program, and a program address. The program address is disclosed in column 9, lines 55-60 of Yuen et al. as being an absolute tape counter-value.

In reading the claimed invention on the Yuen et al. patent, the Examiner appears to be reading Applicants' claimed relative position data on Yuen et al.'s directory information. However, as explained during the interview, the program address in Yuen et al. is not relative position information, as claimed. The program address in Yuen et al. does not show or suggest that the associated relative position data, for each specific data, is indicative of a current nth specific data location on the digital video recording medium to each of a n+1, n+2, ..., n+m specific data location on the digital video recording medium,

where m is greater than 2. Hence, Yuen et al. fails to cure the second and third deficiencies of Ishii et al., as noted above.

The Examiner has taken Official notice that a digital VCR is old and well known. This may be so, but most all inventions are formed by the combination of old and well known components. So this fact, alone, is of little consequence. The question must be whether one of ordinary skill in the art would have been motivated to modify either Ishii et al. or Yuen et al., and whether such a modification would have been within the level of ordinary skill in the art.

It is respectfully submitted that no motivation to make the Examiner's modification exists in the prior art, and any motivation to make the modification could only be based upon hindsight gained from a reading of the Applicants' disclosure. Further, it is contended that such a modification, if made, would be unobvious to one of ordinary skill in the art.

As discussed during the Examiner Interview of June 6, 2001, one skilled in the art would not have found it obvious to have modified the apparatus of Yuen et al. to record digital data. After all, such a modification would eliminate the vertical blanking interval into which the directory information was recorded. Also, as discussed during the interview, even if one of ordinary skill in the art were to have modified Yuen et al. to record digital data, the claims would still not read on the modified device of Yuen et al.

The fourth and fifth teaching references of Enokida and Naimpally fail to cure the deficiencies of the primary three references of Ishii et al., Yuen et al. and the Examiner's Official notice, as argued above. Therefore, for the reasons set forth above, Applicants respectfully request that the Examiner reconsider and withdraw these rejections.

CONCLUSION

In the event that any outstanding matters remain in this application, Applicants request that the Examiner contact Scott L. Lowe (Reg. No. 41,458) at (703) 205-8000 to discuss such matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Very truly yours,
BIRCH, STEWART, KOLASCH & BIRCH, LLP

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Attachments: Version with Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

The claims have been amended as follows:

23. (Four Times Amended) An apparatus for controlling recording in a digital video recording device, comprising:

an input unit receiving digital video data, the digital video data including I-frames of intra-coded digital picture data;

a data generating circuit generating a plurality of relative position data, each of the plurality of relative position data associated with one of a plurality of specific data in the received digital video data, wherein the specific data includes the intra-coded digital picture data, and wherein each of the plurality of relative position data is [and] indicative of a plurality of relative positions from a current nth specific data location on a digital recording medium to each of a n+1, n+2, ..., n+m specific data location on the digital recording medium, where m is greater than 2; and

a recording unit coupled to the data generating circuit and recording the digital video data and the plurality of relative position data on the [a] digital recording medium such that each specific data includes the associated relative position data, as well as the intra-coded digital picture data.

33. (Four Times Amended) An apparatus for controlling reproduction in a digital video reproducing device, comprising:

a reproducing unit reproducing digital video data, the digital video data including I-frames of intra-coded digital picture data stored on a digital recording medium, the digital data including a plurality of specific data, each of said plurality of specific data including relative position data and intra-coded digital picture data, each relative position data indicative of a plurality of relative positions from a current n th specific data location on a digital recording medium to each of a $n+1$, $n+2$, ..., $n+m$ specific data location on the digital recording medium, where m is greater than 2;

a detection circuit coupled to the reproducing unit and detecting one of the plurality of relative position data from the reproduced digital video data; and

a control circuit coupled to the detection circuit, receiving a command and controlling the reproducing unit to reproduce at least another specific data based on the detected relative position data and the command.

42. (Four Times Amended) A method for controlling recording in a digital video recording device, comprising the steps of:

receiving digital video data, the digital video data including I-frames of intra-coded digital picture data;

generating a plurality of relative position data, each of the plurality of relative position data associated with one of a plurality of specific data in the received digital video data, wherein the specific data includes the intra-coded digital picture data, and wherein each of the plurality of relative position data is [and] indicative of a plurality of relative positions from a current nth specific data location on a digital recording medium to each of a n+1, n+2, ..., n+m specific data location on the digital recording medium, where m is greater than 2; and

recording the digital video data and the plurality of relative position data on the [a] digital medium such that each specific data includes the associated relative position data, as well as the intra-coded digital picture data.

52. (Four Times Amended) A method for controlling reproduction in a digital video reproducing device, comprising the steps of:

reproducing digital video data, the digital video data including I-frames of intra-coded digital picture data stored on a digital recording medium, the digital video data including a plurality of specific data, each of said plurality of specific data including relative position data and intra-coded digital picture data, each relative position data indicative of a plurality of relative positions from a current nth specific data location on a digital recording medium to each

of a $n+1$, $n+2$, ..., $n+m$ specific data location on the digital recording medium,
where m is greater than 2;

detecting one of the plurality of relative position data from the
reproduced digital video data;

receiving a command; and

reproducing at least another specific data based on the detected relative
position data and the command.

59. (Amended) The apparatus of claim 23, further comprising:
a detection circuit coupled to the input unit and detecting the specific
data from the received digital video data; and wherein
the data generating circuit is coupled to the detection circuit.

60. (Amended) A digital video recording medium having a data structure
for controlling a reproducing operation, comprising:

a plurality of specific data areas, each specific data area storing digital
specific data including intra-coded digital picture data and associated relative
position data, the associated relative position data indicative of a plurality of
relative positions from a current n th specific data location on the digital video
recording medium to each of a $n+1$, $n+2$, ..., $n+m$ specific data location on the
digital video recording medium, where m is greater than 2.